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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,723	01/29/2001	Peter G. Webb	10010016-1	1312

7590 10/03/2005

AGILENT TECHNOLOGIES  
Legal Department, 51U-PD  
Intellectual Property Administration  
P.O. Box 58043  
Santa Clara, CA 95052-8043

EXAMINER

SMITH, CAROLYN L

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/772,723

Applicant(s)

WEBB, PETER G.

Examiner

Carolyn L. Smith

Art Unit

1631

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 13 September 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-14 and 45-54.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_

*Marjorie A. Moran*  
9/28/05  
**MARJORIE A. MORAN  
PRIMARY EXAMINER**

Continuation of 11. does NOT place the application in condition for allowance because: arguments presented by Applicant are considered unpersuasive. Therefore, all rejections are maintained except for the 35 USC 112, 1<sup>st</sup> paragraph NEW MATTER rejection pertaining to the limitation "using said map identifier to identify vessels corresponding to regions of the array" limitation in amended claim 53 and the 35 USC 112, 2nd paragraph rejection for claim 54.

#### 35 USC 112, 1st paragraph (NEW MATTER) rejections

Regarding the "providing" step, Applicant argues that instant claims 1 and 8 do not require the identity of who provides the starting material, only that the plurality of vessels be provided. This statement is found unpersuasive as the amended limitations must be within the same scope as the written support provided in the originally disclosed application. Provision by the customer is found in the specification, while the broader scope of general provision by anyone is not adequately supported in the original disclosure.

Regarding the "using said map identifier to identify vessels corresponding to regions of the array" limitation in claim 53, Applicant has pointed to adequate support (page 10, lines 14-17) for this limitation.

Regarding the "wherein each of said vessels is marked with a unique identifier that is not composition information from that vessel" limitation of claim 54, Applicant refers to the examples on page 10, lines 17-22 and Table 1. It is noted that these are examples (including the "such as" examples) which means that other unique identifiers are possible. It is repeated that there is no specific support for the negative limitation including a unique identifier that is not composition information. Examples do not provide specific support, therefore Applicant's arguments are considered unpersuasive.

#### 35 USC 112, 2<sup>nd</sup> paragraph rejections

Regarding the "providing a plurality" limitation, Applicant suggests that the providing limitation specifies that biopolymer starting materials are contained in a plurality of source vessels wherein biopolymers get deposited onto an array. Applicant states that three different trays are each "provided" that contain a plurality of vessels. Applicant submits that one of skill in the art reading the specification would know the metes and bounds of the phrase "providing a plurality". These statements do not address the rejection which inquires who and to whom such providing is taking place, as it isn't clear which scenario is intended.

Regarding the "each member" limitation, Applicant contends that one skilled in the art would understand the meaning based on a specification disclosure of each vessel. This statement is found unpersuasive as each member can refer to multiple entities, such as each vessel or each biopolymer or each set of biopolymers. While the claims are read in light of the specification, specific recitations of the specification are not to be read into the claims unless specifically stated in the claims.

Regarding the "corresponding to" limitation, Applicant submits that it is well known that array fabrication involves depositing at predetermined locations on a substrate such that each original source vessel contains a specific biopolymer and has a corresponding region on the array in which the biopolymer has been deposited. These statements are found unpersuasive as Applicant did not clarify what criteria and to what degree these criteria must be met.

#### 35 USC 103 rejection

Applicant argues that the unique identifier is the unique format identifier assigned to the original vessel prior to fabrication of the array and cannot be interpreted to also include the biopolymer itself. This statement is found unpersuasive as there is no known definition in the original disclosure stating that the identifier cannot include the biopolymer itself. Therefore, the identifier is interpreted broadly and reasonably. Applicant argues that the phrase "unique format identifier" means an identifier with respect to the specific vessel, i.e. "tray number, column number, row number" and not the biopolymer in the vessel. This statement is found unpersuasive as the "tray number, column number, row number" is merely an example, as noted by the "i.e.". An example does not set forth a clear and concise definition of that may and may not be interpreted as the identifier. Applicant refers to page 18, lines 5-10 that recites "once a processor has obtained the identify map it can obtain additional array layout information, such as sequence identity of polynucleotides..." Again, the such as is merely an example and not a clear and concise definition of the "unique format identifier". Therefore, the "unique format identifier" may be interpreted broadly and reasonably to include the biopolymer. Applicant argues that the unique format identifier may not include the biopolymer, so that the cited references fail to teach the elements of the claimed invention. This statement is found unpersuasive as the unique format identifier can broadly and reasonably include the biopolymer. Because Applicant's arguments are considered unpersuasive, the rejection is maintained.